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PATENT
Attorney Docket No. 021024-000110US

TOWNSEND and TOWNSEND and CREW LLP

By: Kay Barclay

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Gregory F. Borton

Application No.: 09/813,636

Filed: March 21, 2001

For: ACTIVITY-BASED BUSINESS
MODELING

Confirmation No. 3366

Examiner: Tan D. Nguyen

Technology Center/Art Unit: 3629

APPEAL BRIEF UNDER
37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal mailed on May 16, 2006 for the above-referenced application, Appellant submits this Brief on Appeal.

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1. REAL PARTY IN INTEREST

At the time of the filing of this appeal brief, Primary Matters, Inc. is the real party in interest for this appeal.

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, are directly affected by, or have a bearing on the board decision of the pending appeal.

3. STATUS OF CLAIMS

Claims 1-12 and 19-24 are currently pending in the application, but stand rejected by the U.S. Patent and Trademark Office (hereinafter "Office"). Claims 1-18 were originally filed in the application on March 21, 2001. Claims 13-18 were canceled, and claims 19-24 were added, by an Amendment filed May 5, 2005.

Claims 1-12 and 19-24 are believed improperly rejected and are the subject of this appeal. A copy of the claims as rejected is attached as an Appendix.

4. STATUS OF AMENDMENTS

An Amendment filed October 28, 2005 was objected to under 35 U.S.C 132(a) in the Final Office Action dated March 16, 2005 ("Final Office Action"), as the Examiner alleged that it introduced new matter. The Examiner objected to the amendment to claim 1 specifying that "each task entry is assigned a subset of the plurality of resources." The objection is without merit, as support in the Specification is clear (Original Application, p. 7, l. 33 - p. 8, l. 31; Figs. 2A-2C).

All other claims amendments have been entered. No amendments have been filed subsequent to the Final Office Action.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Each of independent claims 1, 7, and 19 relates to a method for activity-based business modeling. Each of these claims recites receiving one or more task entries based on

defined types of future action (Original Application, p. 5, ll. 1-18; Ref. Num. 212, Figs. 2B and 2C). Instead of looking backward to past activities, the tasks constitute various components which may be combined in different ways to accomplish a variety of different future activities. This distinction is illustrated by examples cited in the Specification, which include research, cold calls, and follow up letters (Id., p. 5, ll. 4-9). The task entries are generic components of action that can be combined to complete different activities in the future.

Each of claims 1, 7, and 19 recites receiving one or more resource entries comprised of defined types of personnel, hardware, software, services, or combinations thereof which are presumed to be available in the future (Id., p. 5, ll. 19-31; Ref. Num. 216, Figs. 2B and 2C). Task entries are then correlated, or mapped, with resource entries (Id., p. 5, l. 32 - p. 6, l. 12; p. 8, ll. 14-34; Figs. 2B and 2C). Thus, for a given task, one or more resources may be associated with it to identify the resources which may be required to accomplish the task.

Claims 1 and 7 recite that the correlated task and resource entries are then processed by a computer to formulate a business model (Id., p. 2, ll. 15-29; Ref. Num. 104, Fig. 1). Forward looking reports related to the business model are then generated (Id., p. 2, ll. 19-21; p. 7, ll. 21-30; Ref. Num. 132, 136, 140, Fig. 1).

Claim 19 recites receiving at least one activity entry (Id., p. 7, l. 33 - p. 8, l. 31; Ref. Num. 208, Figs. 2A-2C). Activity entries are then associated with task entries (Id., p. 2, ll. 2, 8-9, p. 8, ll. 23-30; Figs. 2A-2C). Claim 19 further recites that the correlated activity, task and resource entries are then processed by a computer to formulate a business model (Id., p. 2, ll. 15-29; Ref. Num. 104, Fig. 1). Again, forward looking reports related to the business model are generated (Id., p. 2, ll. 19-21; p. 7, ll. 21-30; Ref. Num. 132, 136, 140, Fig. 1).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Ground of Rejection I: Claims 1-6, 22, 7-12, and 19-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,799,286 to Morgan et al. (hereinafter "Morgan").

Ground of Rejection II: Claims 1-6, 22, 7-12, 19-21, 23 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2001/00132092 to Calver (hereinafter "Calver").

Ground of Rejection III: Claims 23 and 24 stand rejected under 35 U.S.C. §102(e) as being anticipated by Morgan.

Ground of Rejection IV: Claims 1-6, 22, 7-12, 19-21 stand rejected under 35 U.S.C. §101 based on the assertion that the claimed invention is directed to non-statutory subject matter.

Ground of Rejection V: Claims 1-6, 22, 7-12, 19-21, 23 and 24 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Ground of Rejection VI: Claims 1-6, 22, 7-12, 19-21, 23 and 24 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter.

Ground of Objection I: Claim 1 stands objected to, as an Amendment filed October 28, 2005 was objected to under 35 U.S.C 132(a) in the Final Office Action in wherein the Examiner alleged that it introduced new matter. The Examiner objected to the amendment to claim 1 specifying that "each task entry is assigned a subset of the plurality of resources."

Ground of Objection II: Claims 2, 8-11, 23, and 24 stand objected to under 35 U.S.C. §1.75 (c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

7. ARGUMENT

Ground of Rejection I: Claims 1-6, 22, 7-12, and 19-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,799,286 to Morgan et al. (hereinafter "Morgan"). For at least the reasons that follow, Appellant respectfully requests that this rejection be reversed.

The Office Action has rejected claims 1-6, 22, 7-12 and 19-21 under 35 U.S.C. §103(a) as being unpatentable over Morgan. To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP §2143. Appellant believes significant limitations from independent claims 1, 7 and 19 are neither taught nor suggested in the references. More specifically, Morgan cannot be relied upon to teach or suggest: (1) a plurality of task or resource entries comprised of future actions, recited in claims 1, 7, and 19, (2) the mapping recited in claims 1 and 19 or (3) the processing of claim 7. Appellant respectfully requests that the anticipation rejection be withdrawn for these reasons.

1. Task and Resource Entries: Each of independent claims 1, 7, and 19 recites task entries each "comprised of defined types of future action." The Office cites the Morgan "reports for ... trending, forecasting ... [and] benchmarking" to read on the "task entries" of the claims (Final Office Action, p. 8, ll. 4-7). Morgan, however, describes a "forecasting or budget-generating scenario, [wherein] the automated activity-based management system 10 preferably uses *historical activity information*, in addition to estimated projections for certain *equipment utilization*, *activity cost information*, and *product volume*" (Morgan, col. 7, ll. 56-60).

The "tasks" described in the present embodiments comprise "defined types of *future action*" (emphasis added). These "tasks" constitute various components which may be combined in different ways to accomplish a variety of different activities (Original Application, p. 5, ll. 2-3). The task entries are generic components (e.g., research, cold calls, and follow up) of action that can be combined to complete different activities (e.g., sales) in the future (Id., p. 5, ll. 3-4).

But the Morgan forecasting is based on *historical* information and projections for equipment utilization, activity cost information, and product volume - not *tasks* (Morgan, col. 3, l. 66 - col. 4, l. 3). The system in Morgan, for example, looks backward to *specific* employee activities that have *already occurred*, and may make projections based on these past activities (Morgan, p. 8, ll. 32-51; Fig. 10). Morgan, for example, clearly teaches that an *employee or manager* will input backward looking information related to the "time spent" on an activity by people (Morgan, col. 21, line 32). There is a clear distinction between the use of historical data, in Morgan, and the defined types of future action of the claims,

The claims similarly recite resource entries each comprised of "defined types of personnel, hardware, software, services, or combinations thereof which are presumed to be available in the future." The Office Action again states that Morgan reads on the claims, but Morgan clearly describes backward looking utilization information related to personnel, facilities and equipment (Morgan, col. 10, l. 1 - col. 14, l. 39; Figs. 11-14). This information merely attributes *actual, past* personnel, facility and equipment use to certain activities.

2. Mapping: The mapping in claim 1 and 19 calls for future defined tasks to be tied to future resources (personnel and non-personnel) that will be needed to accomplish them. Claim 1 is also amended to recite aspects of the invention more particularly. The Office directs us to the following section of Morgan to read on this mapping: the "traditional general ledger view of a computer network operation business unit maps the money spent to salaries, hardware, software, maintenance, and space. The activity-based management view maps these same *expenditures to activities*" (emphasis added, Morgan col. 4, lines 1-4).

But as is made clear above, the mapping in claim 1 and 19 is directed at mapping future *tasks* to future *resources*, whereas Morgan maps "**expenditures to activities**" (emphasis added, Id., col. 4, ll. 21-24). Claim 1 makes this distinction even more clear, specifying that with the mapping, "each task entry is assigned a subset of the plurality of resources." It is evident that the expenditure/activity mapping of the reference fails to teach the task/resource mapping of these claims. Claim 7 contains limitations similar to the *mapping* of claims 1 and 19, reciting that a task entry and resource entry be *correlated*.

3. Processing Before Any Historical Information Entry: Independent claim 7 recites “processing the resource entry and the task entry with a computer before entry of any historical information for the organization ... [to formulate] a business model.” But there is no teaching or suggestion in Morgan which reads on this limitation. The Office, in rejecting this claim, merely refers to its discussion regarding claim 1 (Office Action, p. 10, ll. 12-14). Claim 7 differs from claim 1 in that it specifically sets forth this additional limitation. This limitation is not addressed in the Office Action, and not found in Morgan.

Morgan, instead, describes a "forecasting or budget-generating scenario, [wherein] the automated activity-based management system 10 preferably uses *historical activity information*, in addition to estimated projections for certain *equipment utilization*, activity *cost information*, and *product volume*" (Morgan, col. 7, ll. 56-60). There is simply no suggestion of processing before the entry of this historical information.

Ground of Rejection II: Claims 1-6, 22, 7-12, 19-21, 23 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2001/00132092 to Calver (hereinafter "Calver"). For at least the reasons that follow, Appellant respectfully requests that this rejection be reversed.

The Office, in citing Calver, provides no explanation of the relevance of referenced sections. "The pertinence of each reference, if not apparent, **must be clearly explained**" (emphasis added, 37 CFR 1.104(c)(2)). The Office instead cites paragraph numbers of an application that is directed at a web based portal for small business, and these paragraphs clearly do not teach or suggest the claim limitations. The lack of *any* guidance from the Office renders it unclear how Calver is relevant, as this reference plainly fails to teach the claim limitations.

Ground of Rejection III: Claims 23 and 24 stand rejected under 35 U.S.C. §102(e) as being anticipated by Morgan. For at least the reasons that follow, Appellant respectfully requests that this rejection be reversed.

Claims 23 and 24 each depend from claim 1, and are allowable based on their dependence from an allowable base claim.

Ground of Rejection IV: Claims 1-6, 22, 7-12, 19-21 stand rejected under 35 U.S.C. §101 based on the assertion that the claimed invention is directed to non-statutory subject matter. For at least the reasons that follow, Appellant respectfully requests that this rejection be reversed.

The independent claims 1, 7, and 19 produce a useful result, including steps for "*generating a forward-looking report.*" These claims are not drawn to abstract ideas, but to tangible and concrete ideas related to the production of a tangible result. Examples cited in the Published Specification include a head count report, a multi-year projection, and an activity-based costing report. Clearly, processes related to the creation of a forward-looking report produce a tangible result.

Ground of Rejection V: Claims 1-6, 22, 7-12, 19-21, 23 and 24 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. For at least the reasons that follow, Appellant respectfully requests that this rejection be reversed.

The Appellant respectfully asserts that the mapping at issue is clearly supported in the Specification (Original Application, p. 8, ll. 14-30; Figs. 2A & 2B).

Ground of Rejection VI: Claims 1-6, 22, 7-12, 19-21, 23 and 24 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. For at least the reasons that follow, Appellant respectfully requests that this rejection be reversed.

The Office appears to assert that there is confusion about use of the term "entry" as it is used in the claims. However, the claims are not to be viewed in a vacuum, but in light of the Specification (See, e.g., *Phillips v. AWH Corp.*, Fed. Cir., No. 03-1269, 7/12/05).

Throughout the Specification, the term "entry" is used on numerous occasions, and the use in the claims is abundantly clear. For example, the Specification provides: "*tasks, resources, and systems* for many common business areas are available in templates to pre-populate the various data *entry* screens" (emphasis added, Original Application, p. 7, ll. 11-12). And the interaction between tasks, resources, systems, and entry screens is made clear as well (*Id.*, p. 8, ll. 2-4). Appellant respectfully asserts that the claims at issue are clear in light of the Specification.

Claim 6 addresses the term "organization," and the Office again asserts a lack of clarity. The Appellant respectfully disagrees, as support for the meaning ascribed in claim 6 is found in the Specification, and is clear (*Id.*, p. 3, ll. 4-5). This rejection of claim 6 is respectfully traversed.

Ground of Objection I: An Amendment filed October 28, 2005 was objected to under 35 U.S.C 132(a) in the Final Office Action as the Examiner alleged that it introduced new matter. For at least the reasons that follow, Appellant respectfully requests that this objection be reversed.

The Examiner objected to the amendment to claim 1 specifying that "each task entry is assigned a subset of the plurality of resources." The objection is without merit, as support in the Specification is clear (Original Application, p. 7, l. 33 - p. 8, l. 31; Figs. 2A-2C).

Ground of Objection II: Claims 2, 8-11, 23, and 24 are objected to under 35 U.S.C. §1.75 (c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. For at least the reasons that follow, Appellant respectfully requests that this objection be reversed.

As noted in the previous Amendment dated May 5, 2005, claim 2 depends from claim 1, and further comprises "a step of attributing overhead expenses to the organization as a whole." This clearly is more limiting than claim 1. As the Published Specification points out in [0016], information could be input for the organization *or* individual personnel or systems.

Claim 2 requires that certain overhead expenses be attributed to the organization as a whole, which would exclude individual personnel, for example, and thus is more limiting.

Claims 8-11, 23 and 24 are dependent claims which, like claim 2, more particularly point out certain aspects of the claimed embodiments. When a dependent claim more particularly describes an aspect of an independent claim, other options for performing that claim then are foreclosed. For example, in claim 8, the "step of processing an activity entry" is included. In independent claim 7 (from which claim 8 depends), that step may, or may not, be included. Claim 8 is thus more limiting. Similar reasoning applies to the rest of the claims as well.

For at least the foregoing reasons, independent claims 1, 7 and 19 are allowable. Claims 2-6, 8-12, and 18- 24 depend from the independent claims, and are each allowable at least based on their dependence from an allowable base claim.

8. CONCLUSION

For these reasons, it is respectfully submitted that the rejection should be reversed.

Respectfully submitted,



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9. CLAIMS APPENDIX

1. (Previously Presented) A method for activity-based business modeling for an organization that doesn't require historical information from a general ledger, the method comprising steps of:

receiving a plurality of task entries, wherein each task entry is comprised of defined types of future action which will generate a result;

receiving a plurality of resource entries, wherein each resource entry is comprised of defined types of personnel, hardware, software, services, or combinations thereof which are presumed to be available in the future;

receiving mapping information that shows a relationship between each of the task entries and the plurality of resource entries, wherein each task entry is assigned a subset of the plurality of resources;

processing the plurality of task entries, the plurality of resource entries and the mapping information with a computer to formulate a business model; and

generating a forward-looking report after the processing step and related to the business model.

2. (Previously Presented) The method for activity-based business modeling for the organization as recited in claim 1, further comprising a step of attributing overhead expenses to the organization as a whole.

3. (Previously Presented) The method for activity-based business modeling for the organization as recited in claim 1, wherein one of the plurality of resource entries is associated with at least one system entry.

4. (Previously Presented) The method for activity-based business modeling for the organization as recited in claim 1, wherein:

at least one of an activity entry, the resource entry, the task entry, and a system entry is derived from a template; and

the template is not produced by an end user.

5. (Previously Presented) The method for activity-based business modeling for the organization as recited in claim 1, further comprising a step of retrieving at least one of the plurality of task entries and the plurality of resource entries from a predefined template.

6. (Original) The method for activity-based business modeling for the organization as recited in claim 1, wherein the organization comprises at least one of a project(s), a department(s), a whole company, and a family of companies.

7. (Previously Presented) A method for activity-based business modeling for an organization without requiring historical information from a general ledger for the organization, the method comprising steps of:

receiving a task entry and a resource entry wherein:

the task entry comprises a defined type of future action which will generate a result; and

the resource entry comprises a defined type of personnel, hardware, software, services, or combination thereof which is presumed to be available in the future;

correlating the task entry to the resource entry;

processing the resource entry and the task entry with a computer before entry of any historical information for the organization, wherein a business model for the organization is formulated;

generating a forward-looking report using the business model.

8. (Original) The method for activity-based business modeling for the organization as recited in claim 7, further comprising a step of processing an activity entry.

9. (Original) The method for activity-based business modeling for the organization as recited in claim 7, further comprising a step of processing a system entry.

10. (Original) The method for activity-based business modeling for the organization as recited in claim 9, further comprising a step of determining a demand for the system entry for an activity volume.

11. (Original) The method for activity-based business modeling for the organization as recited in claim 7, wherein the forward-looking report is chosen from the group consisting of: a head count report, a multi-year projection, and an activity-based costing report.

12. (Original) The method for activity-based business modeling for the organization as recited in claim 7, further comprising steps of:

processing an activity entry; and

processing a system entry, wherein:

at least one of the activity entry, the resource entry, the task entry, and the resource entry is derived from a template; and

the template is not produced by an end user.

13.-18. (Cancelled)

19. (Previously Presented) A method for activity-based business modeling for an organization that doesn't require historical information from a general ledger, the method comprising steps of:

receiving at least one task entry, wherein:

each task entry comprises a defined type of future action which will generate a result; and

each task entry has a projected volume and projected duration;

receiving at least one resource entry, which comprises a defined type of personnel, hardware, software, services, or combination thereof which is presumed to be available in the future;

receiving at least one forward looking activity entry;

receiving mapping information that shows a relationship between each of the task entries and the plurality of resource entries;

associating at least one forward looking activity entry with at least one of the task entries;

processing the task entries, resource entries, system entries, the mapping information, and the activity entries with a computer to formulate a business model; and

generating a forward-looking report after the processing step and related to the business model.

20. (Previously Presented) The method for activity-based business modeling for the organization recited in claim 19, wherein the processing is based on a predefined template.

21. (Previously Presented) The method for activity-based business modeling for the organization recited in claim 19, wherein:

at least one resource entry includes personnel;

the forward looking report includes productivity and cost information related to the personnel.

22. (Previously Presented) The method for activity-based business modeling for the organization as recited in claim 1, wherein the task entries have a projected volume and projected duration.

23. (Previously Presented) A computer-readable medium having computer-executable instructions for performing the computer-implementable method for activity-based business modeling of claim 1.

24. (Previously Presented) A computer system adapted to perform the computer-implementable method for activity-based business modeling of claim 1.

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10. EVIDENCE APPENDIX

None.

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11. RELATED PROCEEDINGS APPENDIX

None.